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| 09/819,244 | 03/28/2001 | Satoru Ueda | 450100-03099 | 2106 |

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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

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| EXAMINER |
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STRANGE, AARON N

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| ART UNIT | PAPER NUMBER |
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2153

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,244

Applicant(s)

UEDA, SATORU

Examiner

Aaron Strange

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

2. Claims 1, 2,4 and 6 are objected to because of the following informalities:
3. With regard to claim 1, the preamble of the claim is misdescriptive. The system as claimed fails to perform "certificating the contents of an electronic mail". The claims describe a system where email messages are stored in a database upon verification of the sender and then forwarded to their destination. No certification of contents occurs in the claimed invention.
4. With further regard to claim 1, the Office recommends that lines 4-5 be amended to read "telecommunication line, said system comprising:" to clarify what is comprised by the elements in the body of the claim.
5. Claim 2 appears to contain a typographical error "any one of" in line 9. The Office recommends that the claim be amended to read "either of".
6. Claim 4 appears to contain a typographical error "said electronic mail has been received by electronic mail" in lines 5-6. The Office recommends that the claim be amended to read "said electronic mail has been received".
7. Claim 6 appears to contain a typographical error "identifying a sender" in

line 4. The Office recommends that the claim be amended to read "identifying the sender".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

10. With regard to claim 1, the phrase "said electronic mail communicated between" in lines 23-24 and lines 29-30 is not supported by the specification. In the specification, the first attorney communicates with the first party prior to the message being transmitted from the first party to the second party. The language of the claim implies that the first attorney communicates "the electronic mail" with the first party in regard to an electronic mail previously communicated. Likewise, the specification shows the second attorney communicates with the second party prior to the reply message being transmitted from the second party to the first party. The language of the claim implies that the second attorney communicates "the electronic mail" with the second party in regard to an electronic mail previously communicated.

For the purpose of applying prior art, this claim has been interpreted to mean that the attorneys communicate with the parties regarding an electronic mail that has not yet been sent.

11. With regard to claim 2, the limitation "said first party communication terminal can select" in lines 8-9 is not supported by the specification. In the specification the first communication party selects where to transmit the message, rather than the terminal making the selection. For the purpose of applying art, this limitation has been interpreted as "a user of said first party communication terminal can select" a transmission.

12. With further regard to claim 2, the functionality of the party button and attorney button is not sufficiently described in the specification. The specification describes that a message is transmitted to the other party communication terminal or the attorney communication terminal responsive to the chosen button. However, the specification fails to specify how the user notifies the party communication terminal which other communication terminal to send the message to. Without having a means of inputting addressing information such as the email of the party and/or attorney to communicate with, the system would be limited to communication between two specific parties with two specific attorneys. The software would have to be customized for each pair of parties and attorneys, rather than allowing the desired party to be specified in the program. It is unclear if Applicant intends for the claimed invention to be limited to communication between two specific, predefined parties and their attorneys, or allow one party to communicate with a plurality of other parties concerning different matters.

13. All claims not individually referred to are rejected by virtue of their dependency from the above claims.

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Some examples include "certificating the contents" (Claim 1, Line 2) and the steps recited in claims 7 and 9.

17. With regard to claim 1, the terms "said electronic mail" and "the electronic mail" are used in several places throughout the claim, such as in lines 15, 18, 21, 23, 27, and 29. It is unclear which electronic mail or electronic mails Applicant intends to refer to. In line 15, "said electronic mail" is communicated by the first party communication terminal with the certification apparatus. In line 18, "said electronic mail" is communicated by the second party communication terminal with the certification apparatus. In lines 23-25, "said electronic mail" is communicated between the first party terminal and the second party terminal. Finally, in lines 29-31, "said electronic mail" is communicated between the second party terminal and the first party terminal. It is unclear if all these references

refer to a single electronic mail. In addition "the electronic mail" is referred to in lines 21 and 27. It is unclear if "the electronic mail" and "said electronic mail" are referring to the same object.

18. With further regard to claim 1, the phrases "communicating said electronic mail with said", in lines 14-15, and 17-18 are unclear. It is unclear whether the electronic mail is transmitted between the terminals and the certification apparatus or if the certification apparatus is used by the terminals to send the electronic mails. For the purpose of applying prior art, the claim has been interpreted as the party terminals sending electronic mails to the certification apparatus and receiving electronic mails from the certification apparatus.

19. Claim 2 recites the limitation "said both electronic transmissions" in lines 9-10. There is insufficient antecedent basis for this limitation in the claim.

20. With further regard to claim 2, the limitation "a screen on said first party communication terminal by means of a GUI (Graphical User Interface) comprises" is unclear. It is unclear whether the Applicant intends for the screen or the GUI to comprise the buttons. For the purpose of applying art, it has been interpreted that the GUI comprises the buttons.

21. Claim 3 recites the limitation "the contract matter" in line 3. There is insufficient antecedent basis for this limitation in the claim.

22. Claim 4 recites the limitation "the reception confirmation information" in line 4. There is insufficient antecedent basis for this limitation in the claim.

23. Claim 5 recites the limitation "the electronic mail that has been encrypted" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

24. With regard to claim 7, the terms "said electronic mail" and "the electronic mail" are used in several places throughout the claim, such as in lines 13, 18, 23, 28, and 33. It is unclear which electronic mail or electronic mails Applicant intends to refer to. It appears that Applicant is claiming the paths which a message composed by the first party will take to reach the second party, as well as the paths a reply from the second party will take to return to the first party. However, the use of "said electronic mail" implies that Applicant is referring to the same electronic mail throughout. A reply to an electronic mail would not be the same electronic mail. In addition, "the electronic mail" is referred to in line 33. It is unclear if "the electronic mail" and "said electronic mail" are referring to the same electronic mail.

25. Claim 8 recites the limitation "the contract matter" in 3. There is insufficient antecedent basis for this limitation in the claim.

26. With regard to claim 9, the terms "said electronic mail" and "the electronic mail" are used in several places throughout the claim, such as in lines 8, 13, 18, 23, and 28. It is unclear which electronic mail or electronic mails Applicant intends to refer to. It appears that Applicant is claiming the paths which a message composed by the first party will take to reach the second party, as well as the paths a reply from the second party will take to return to the first party. However, the use of "said electronic mail" implies that Applicant is referring to the same electronic mail throughout. A reply to an electronic mail would not be the same electronic mail. In addition, "the electronic mail" is

referred to in line 28. It is unclear if "the electronic mail" and "said electronic mail" are referring to the same electronic mail.

27. All claims not individually referred to are rejected by virtue of their dependency from the above claims.

Claim Rejections - 35 USC § 103

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claims 1-3,5, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (US 6,640,301).

30. With regard to claim 1, Ng discloses a communication contents certification system for certifying the contents of an electronic mail communicated between party communication terminals through a telecommunication line comprising: a communication contents certification apparatus (Email web site) (Fig 4, 20') having communication contents receiving means for receiving said electronic mail (Messages are received through email web site) (Col 6, Lines 42-46), communication contents storage means for storing the contents of said electronic mail received by said communication contents receiving means (Copies of sent email can be stored at the email web site) (Col 8, Lines 40-42), and communication contents transmission means for transmitting said electronic mail having the contents stored by said communication

contents storage means (Messages are sent through email web site)(Col 6, Lines 42-46); a first party communication terminal for communicating said electronic mail with said communication contents certification apparatus (terminal containing browser) (Fig 4, 24) (Col 6, Lines 41-58); a second party communication terminal for communicating said electronic mail with said communication contents certification apparatus (terminal containing email client) (Fig 4, 15) (Col 6, Lines 41-58); and charging means for performing charge processing to said first and second parties, for use of said communication contents certification apparatus (Col 14, Lines 23-26).

Ng fails to specifically disclose first and second attorney communication terminals for communicating with the first and second parties. However, Ng suggests that attorneys could benefit by using the system to verify the authenticity of messages sent via the certification system (Col 13, Lines 62-65). By having impartial certification of email messages, the messages cannot be easily forged and could be submitted as evidence in a court of law. This would be particularly advantageous when a lawsuit is filed regarding a contract agreement. All messages sent regarding the contract could be verified with regard to both contents and the time they were sent, creating valuable evidence related to the dispute.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have attorney communication terminals use the system when communicating with their clients regarding legal matters. By having messages certified by time and contents, the attorney and client would have access to the actual discussions that took place in the event of a lawsuit between his client and another or in

the event of a malpractice lawsuit between the client and his attorney. Since the information could not be easily forged, it provides very strong evidence in the case of any disputes.

31. With regard to claim 2, while the system disclosed by Ng shows substantial features of the claimed invention (discussed above), including a GUI (Graphic User Interface) (Col 8, Lines 20-22), and a party button display section for selecting electronic mail communication with said second party communication terminal (Clicking on "Authenticated Send" button sends message to second party via certification apparatus) (Col 8, Lines 25-29), it fails to specifically and an attorney button display section for selecting electronic mail communication with said first attorney communication terminal, and said first party communication terminal can select any one of said both electronic transmissions by use of an operation device.

However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to include an attorney button display and allow the user to select either button to direct the communication because Applicant has not disclosed that a dedicated attorney button display provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well by specifying the attorney's email address and using the "Authenticated Send" button as disclosed by Ng (Col 8, Lines 19-29 and Fig 8A-8D) because both methods perform the required task of sending the message to the user's attorney via the certification apparatus equally well.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by Ng to obtain the invention as specified in claim 2.

32. With regard to claim 3, Ng further discloses that the contents of said electronic mail are the information concerning the contract matter (Terms of Sale) between said first party and said second party (Fig 8A-8D).

33. With regard to claim 5, Ng further discloses that said electronic mail that has been encrypted is transmitted (Col 14, Lines 45-47).

34. With regard to claims 7 and 9, Ng discloses a communication contents certification method for certifying the contents of an electronic mail communicated between party communication terminals and attorney communication terminals through a telecommunication line wherein: communication contents certification means (Email web site) (Fig 4, 20') that is capable of communication with a first party communication terminal (terminal containing browser) (Fig 4, 24) (Col 6, Lines 41-58), a second party communication terminal apparatus (terminal containing email client) (Fig 4, 15) (Col 6, Lines 41-58) by electronic mail and capable of storing the contents of said electronic mail for every communication (Copies of sent email can be stored at the email web site) (Col 8, Lines 40-42) is used, and said electronic mail destined for said second party communication terminal transmitted from said first party communication terminal is received by means of said second said second party communication terminal by way of said communication contents certification apparatus (Emails are sent between terminals via the certification apparatus) (Col 8, Lines 19-29).

Ng fails to specifically disclose first and second attorney communication terminals for communicating with the first and second parties, or that communication between attorney terminals and party terminals occurs via the certification apparatus. However, Ng suggests that attorneys could benefit by using the system to verify the authenticity of messages sent via the certification system (Col 13, Lines 62-65). By having impartial certification of email messages, the messages cannot be easily forged and could be submitted as evidence in a court of law. This would be particularly advantageous when a lawsuit is filed regarding a contract agreement. All messages sent regarding the contract could be verified with regard to both contents and the time they were sent, creating valuable evidence related to the dispute.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have attorney communication terminals use the system when communicating with their clients regarding legal matters. By having messages certified by time and contents, the attorney and client would have access to the actual discussions that took place in the event of a lawsuit between his client and another or in the event of a malpractice lawsuit between the client and his attorney. Since the information could not be easily forged, it provides very strong evidence in the case of any disputes.

35. With regard to claim 8, Ng further discloses that the contents of said electronic mail are the information concerning the contract matter (Terms of Sale) between said first party and said second party (Fig 8A-8D).

36. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (US 6,640,301) in view of Zabetian (US 6,327,656).

37. With regard to claim 4, while the system disclosed by Ng shows substantial features of the claimed invention (discussed above), it fails to specifically disclose that said first and second party communication terminals that receive said electronic mail transmit the reception confirmation information for indicating that said electronic mail has been received by electronic mail, said communication contents receiving means further receives said reception confirmation information transmitted from said first and second communication terminals, and said communication contents storage means further stores said reception confirmation information received by said communication contents receiving means.

Zabetian teaches a method of confirming the reception of an electronic mail by having the recipient notify the certification requester (the certification apparatus in this case) upon successful receipt of the message. Zabetian discloses that this can be accomplished through a conventional return receipt or through an active login procedure to the email web site. Either method would provide confirmation that the recipient had received the message. This is advantageous because it can provide proof that the document was delivered at a certain time, which would be potentially important information when dealing with legal matters.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to require confirmation of receipt from the recipient of a certified message, and to store it in the certification apparatus. This would provide proof

of the time a message was received by the recipient and track that information in the certification apparatus. Proof of delivery would be very important for certain legal documents, and would be an advantageous addition to the system disclosed by Ng.

38. With regard to claim 6, while the system disclosed by Ng shows substantial features of the claimed invention (discussed above), it fails to specifically disclose that said communication contents certification apparatus further comprises party identification means for identifying a sender of said transmitted electronic mail.

Ng discloses that the authentication service supports accounts for users of the authentication service. Users with accounts automatically have their messages authenticated (Col 9, Lines 41-45). Zabetian teaches several methods of registering users for email service so their identity can be confirmed (Col 6, Line 54 to Col 7, Line 3). This provides an additional layer of security that is particularly important for legal matters. By ensuring that the sender of the message is the actual person the message claims to be from, it provides much stronger evidence for use in legal proceedings.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a mechanism to verify the identity of a sender of a message. This ensures that the message is actually coming from the person stated in the message header, providing much stronger evidence in regard to legal matters, by greatly reducing the chances that a message is forged.

Conclusion


39. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 703-305-8878. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ANS 7/8/2004


GLEN BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100